

REMARKS

By this amendment, Applicants amend claims 1, 24-27 and 31. Claims 1-10 and 16-31 remain pending.

In the Office Action¹ mailed April 2, 2008, the Examiner rejected claims 24, 27, and 30 under 35 U.S.C. § 112, second paragraph; and rejected claims 1-10 and 16-31 under 35 U.S.C § 103(a) as being unpatentable over U.S. Patent No. 6,058,413 to Flores ("*Flores*") in view of U.S. Published Patent Application No. 2005/0177507 to Bandyh et al. ("*Bandyh*"). Applicants respectfully traverse each of the Examiner's rejections.

I. Interview

Applicants thank the Examiner for granting the May 29, 2008 telephonic interview with Applicants' representative. Applicants' representative and the Examiner discussed the independent claims and the cited references. Applicants do not necessarily subscribe to any characterizations made in the Interview Summary mailed June 17, 2008.

¹ As Applicants' remarks with respect to the Examiner's rejections are sufficient to overcome these rejections, Applicants' silence as to certain assertions or requirements applicable to such rejections (e.g., whether a reference constitutes prior art, motivation to combine references, etc.) is not a concession by Applicants that such assertions are accurate or such requirements have been met, and Applicants reserve the right to analyze and dispute such in the future.

II. Rejection of Claims 24, 27, and 30 under 35 U.S.C. § 112, Second Paragraph

Applicants respectfully traverse the rejection of claims 24, 27, and 30 under 35 U.S.C. § 112, second paragraph for allegedly being within multiple statutory classes. As stated by the MPEP:

A claim to a device, apparatus, manufacture, or composition of matter may contain a reference to the process in which it is intended to be used without being objectionable under 35 U.S.C. 112, second paragraph, so long as it is clear that the claim is directed to the product and not the process. . . . An applicant may present claims of varying scope even if it is necessary to describe the claimed product in product-by-process terms. *MPEP* 2173.05(p) (emphasis added).

Claim 24 is clearly directed to a computer program, and therefore does not fall within multiple statutory classes. Accordingly, Applicants respectfully request that the Examiner withdraw the rejection of claim 24, and dependent claims 27 and 30, under 35 U.S.C. § 112, second paragraph.

III. Rejection of Claims 1-10 and 16-31 under 35 U.S.C § 103(a)

Applicants respectfully traverse the rejection of claims 1-10 and 16-31 under 35 U.S.C § 103(a) as being unpatentable over *Flores* in view of *Bandyach*. No *prima facie* case of obviousness has been established.

“The key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. . . . [R]ejections on obviousness cannot be sustained with mere conclusory statements.” *M.P.E.P.* § 2142, 8th Ed., Rev. 6 (Sept. 2007) (internal citation and inner quotation omitted). “The mere fact that references can be combined or modified does not render the resultant

combination obvious unless the results would have been predictable to one of ordinary skill in the art.” M.P.E.P. § 2143.01(III) (emphasis in original). “In determining the differences between the prior art and the claims, the question under 35 U.S.C. 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious. M.P.E.P. § 2141.02(I) (emphases in original).

“[T]he framework for objective analysis for determining obviousness under 35 U.S.C. 103 is stated in *Graham v. John Deere Co.*, 383 U.S. 1, 148 U.S.P.Q 459 (1966). . . . The factual inquiries . . . [include] [a]scertaining the differences between the claimed invention and the prior art.” M.P.E.P. § 2141(II). “Office personnel must explain why the difference(s) between the prior art and the claimed invention would have been obvious to one of ordinary skill in the art.” M.P.E.P. § 2141(III).

Independent claim 1 recites a method for automatically filing documents relating to business transactions using a computer system, including “formatting a first data area of the output data record, such that the first data area is compatible with a first business application,” and “formatting a second data area of the output data record, such that the second data area is compatible with a second business application.” On page 3, the Office Action concedes that *Flores* does not disclose the claimed “output data record,” and instead alleges that *Bandyach* discloses the claimed “output data record.”

Applicants respectfully submit that this is not correct.

With respect to Figure 10, *Bandyach* discloses various collaborative back offices (CBOs) that send data to trade engine 182 via trade integration module 192. Trade integration module 192 “pulls data from the CBO system and provides data

conversion . . . to communicate the data to the central trade engine 182.” *Bandyach*, ¶ [0121].

Bandyach’s converted data for communication does not constitute or suggest the claimed “output data record,” at least because *Bandyach* does not teach or suggest “formatting a first data area of the output data record, such that the first data area is compatible with a first business application,” and “formatting a second data area of the output data record, such that the second area is compatible with a second business application,” as recited in claim 1 (emphasis added). Instead, *Bandyach*’s communicated data is converted only to be compatible with trade engine 182, and does not include “the second data area [that] is compatible with a second business application,” as recited in claim 1.

Moreover, one of ordinary skill in the art would not modify *Bandyach*’s communicated data to include the claimed “second data area.” *Bandyach*’s communicated data has a single destination (trade engine 182), and therefore has no need for “a second data area [that] is compatible with a second business application,” as recited in claim 1. Accordingly, “a second data area” would provide no utility for *Bandyach*, and one of ordinary skill in the art would not modify *Bandyach* in this manner.

In view of the failure of the prior art to teach or suggest a combination including the elements of claim 1 discussed above, the Office Action has failed to properly determine the scope and content of the prior art and to properly ascertain the differences between the prior art and the claimed invention. Thus, the Office Action has failed to clearly articulate a reason why the claims would have been obvious to one of ordinary skill, in view of the prior art. Accordingly, no *prima facie* case of obviousness

has been established, and the Examiner should withdraw the rejection of independent claim 1 under 35 U.S.C § 103(a).

Independent claims 10, 24, and 31 while differing in scope from claim 1, comprise similar recitations as claim 1. Accordingly, the Examiner should withdraw the rejection of claims 10 and 24 at least due to the reasons discussed previously.

Claims 2-9, 16-23, and 25-27 depend from one of independent claims 1, 10, and 24. Accordingly, the Examiner should withdraw the rejection of claims 2-9, 16-23, and 25-27 at least due to their dependence.

CONCLUSION

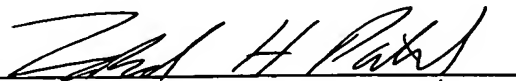
In view of the foregoing, Applicants respectfully requests reconsideration of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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